<div align="center">REMARKS</div>

Claims 1-21 are currently pending in the subject application and are presently under consideration. Claims 1, 7-8 and 15 have been amended as shown on pg. 5-8 of the Reply. In addition, the specification has been amended to cure minor informalities as indicated on pg. 2-4. Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

I.   Objection to Specification

The specification is objected to because of various minor informalities. The specification has been amended herein to cure such informalities. In light of such amendments, it is respectfully requested that this objection be withdrawn.

II.   Rejection of Claims 1-7 Under 35 U.S.C. §101

Claims 1-7 stand rejected under 35 U.S.C. §101 because the claimed invention is allegedly directed towards non-statutory subject matter. Applicants' representative respectfully avers to the contrary; however to expedite fruitful prosecution, claims 1 and 7 have been amended herein. Additionally, in accordance with *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1358 (Fed.Cir. 1999), the subject claims recite a useful, concrete, and tangible result, and are therefore directed towards statutory subject matter.

> Because the claimed process applies the Boolean principle [abstract idea] *to produce a useful, concrete, tangible result* ... on its face the claimed process falls comfortably within the scope of §101. *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1358. (Fed.Cir. 1999) (Emphasis added); *See State Street Bank & Trust Co. v. Signature Fin. Group, Inc.*, 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1601 (Fed.Cir.1998). The inquiry into patentability requires an examination of the contested claims to see if the claimed subject matter, as a whole, is a disembodied mathematical concept representing nothing more than a "law of nature" or an "abstract idea," or if the mathematical concept has been *reduced to some practical application rendering it "useful."* *AT&T* at 1357 *citing In re Alappat*, 33 F.3d 1526, 31 1544, 31 U.S.P.Q.2D (BNA) 1545, 1557 (Fed. Cir. 1994) (Emphasis added) (holding that more than an abstract idea was claimed because the claimed invention as

a whole was directed toward forming a specific machine that produced the useful, concrete, and tangible result of a smooth waveform display).

The subject claims produce useful, concrete and tangible results. The subject invention facilitates configuration of a software system during an installation process according to the location scenario of a computer where the software system is to be installed. A user need not install all components of the software system; rather, a list of recommended software system components for installation is provided to the user according to the location scenario, thereby resulting in saved time and computer resources. The final result is a configured system on a computing device – clearly a useful, concrete and tangible result.

In view of the above, it is readily apparent that the claimed invention reduces to a practical application that produces a useful, concrete, tangible result; therefore, pursuant to *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1358 (Fed.Cir. 1999) the subject claims are directed to statutory subject matter pursuant to 35 U.S.C. §101. Accordingly, this rejection should be withdrawn.

III.   **Rejection of Claims 15-21 Under 35 U.S.C. §101**

Claims 15-21 stand rejected under 35 U.S.C. §101 because the claimed invention is allegedly directed towards non-statutory subject matter. This rejection should be withdrawn for at least the following reasons. Claim 15 has been amended to recite *a computer-readable medium having computer-executable instructions stored thereon for: receiving data indicative of a location scenario corresponding to a location in a network of a device where a software system is to be installed; and configuring the software system based on the location scenario by tuning an adjustable list of recommended software system components for installation based upon the location in the network*. The Examiner has rejected these claims for being interpretable as a carrier wave. Applicants' representative submits that this amendment overcomes the Examiner's rejection, as a carrier wave does not have computer-executable instructions stored thereon, but rather is a transport medium with no storage capabilities.

Additionally, the subject claims produce a useful and concrete and tangible result. More particularly, independent claim 15 recites configuring a software system based on a location scenario by tuning an adjustable list of recommended software system components for installation based upon

the location in the network. Utilizing the invention as claimed, a user needs not undertake the entire installation of all components of the software system; rather, a list of recommended software system components for installation is provided to the user according to the location scenario. Accordingly, claim 15 (and claims dependent therefrom) relates to installation of a software system, and an installed software system is clearly a useful, concrete, and tangible result.

In view of the above, it is readily apparent that the rejection of these claims should be withdrawn.

IV.   Rejection of Claims 1-21 Under 35 U.S.C. §102(e)

Claims 1-21 stand rejected under 35 U.S.C. §102(e) as being anticipated by Halpern *et al.* (US Patent 6,282,711). It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. Halpern *et al.* does not disclose each and every element of the subject claims.

> For a prior art reference to anticipate, 35 U.S.C. §102 requires that
> "*each and every element* as set forth in the claim is found, either
> expressly or inherently described, in a single prior art reference."
> *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950 (Fed.
> Cir. 1999) (*quoting Verdegaal Bros., Inc. v. Union Oil Co.*, 814
> F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)) (emphasis
> added).

The claimed invention relates to selection and/or configuration of software components during an installation process of a software system, wherein such selection and/or configuration is based on a location scenario of a device where the software system is to be installed. To this end, independent claim 1 recites *a setup component that configures a software system based at least in part upon… information pertaining to the location of a device within a network by providing at least one recommended, selectable component for installation corresponding to such location*. Similarly, independent claim 7 recites *computer-implemented means for determining a configuration for a software system based on a position of a computer within a network by yielding a default, customizable subset of software system components*. Additionally, claim 8 recites *selecting a scenario based on a location of a device where a software system is to be installed with respect to disparate devices and determining a*

configuration for the software system based on the selected scenario by providing a default, modifiable subset of software system components for installation corresponding to the location of the device, and claim 15 recites *configuring a software system based on a location scenario by tuning an adjustable list of recommended software system components for installation based upon a location in the network*. Halpern *et al*. fails to disclose, teach, or suggest such aspects.

Rather, Halpern *et al*. discloses configuring a software installation package at a remote server (in a customized manner) in response to user input prior to delivering the software installation package to a client system. (*See* Abstract). Halpern *et al*. discloses that a discovery agent may gather useful information such as client system environment (*e.g.* a list of software components already installed on a client's system and the release version of the components). (*See* col. 5, ll. 25-41). Additionally, Halpern *et al*. notes that a user interface (UI) can be customized to fit the needs and sophistication of particular users (*e.g.* a regular user, a power user, or a system administrator). (*See* col. 4, ll. 59-61). However, Halpern *et al*. is silent with regards to *a setup component that configures a software system based at least in part upon… information pertaining to the location of a device within a network* as claimed.

With still more specificity, Halpern *et al*. also discloses manufacturing a customized software installation package on a server side in response to a user's selection of the software components and options that interest such user. (*See* col. 3, ll. 39-44). Moreover, Halpern *et al*. notes that many preliminary software installation tasks could also be performed at the server location, prior to sending options to the client *via* the user interface template. (*See* col. 5, ll. 55-60). Thus, the teachings of Halpern *et al*. permits users to selectively choose particular software components to create a customized system, but is completely silent with respect to *determining a configuration for a software system based on a position of a computer within a network by yielding a default, customizable subset of software system components* as claimed.

In view of at least the foregoing, it is readily apparent that Halpern *et al*. does not disclose, teach, or suggest the subject invention as recited in independent claims 1, 7, 8 and 15. Accordingly, it is respectfully submitted that the rejection of these claims (and the claims that depend therefrom) should be withdrawn.

CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [MSFTP173US].

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,

AMIN, TUROCY & CALVIN, LLP

  /Himanshu S. Amin/
Himanshu S. Amin
Reg. No. 40,894

AMIN, TUROCY & CALVIN, LLP
24TH Floor, National City Center
1900 E. 9TH Street
Cleveland, Ohio 44114
Telephone (216) 696-8730
Facsimile (216) 696-8731